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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,872	12/16/2003	Michael Clark Campbell	2002-0643.01	4772

21972 7590 05/17/2007  
LEXMARK INTERNATIONAL, INC.  
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LEXINGTON, KY 40550-0999

EXAMINER

LAVIN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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05/17/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/736,872	CAMPBELL, MICHAEL CLARK	
	Examiner	Art Unit	
	Christopher L. Lavin	2624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) 43 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 is/are allowed.
- 6) ☒ Claim(s) 17-42 and 44-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

1. This action is in response to the amendment filed on 02/23/07.

#### ***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 17 – 23, 26, 28, 30, 48 and 50 – 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato (6,141,111) and Iguchi (6,473,153).

In regards to claim 17 Kato discloses, A method for selecting images from a plurality of images obtained from a digital device for printing with an imaging apparatus, said imaging apparatus having a scanner and accessing a memory storing said plurality of images, said method comprising the steps of: printing a thumbnail printout, said thumbnail printout including a plurality of thumbnails corresponding to said plurality of images (Figure 4, item 102; col. 5, lines 25 – 38); generating a selection sheet from said thumbnail printout by placing a first designation mark [directly] on said thumbnail printout for each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a first action is to be taken (Figure 4; col. 5, lines 30 – 47); detecting said first designation mark by scanning said selection sheet with said scanner (col. 6, lines 27 – 38); and performing said first action based on said detecting said first designation mark (col. 5, line 62 – col. 6, line 5).

Kato does not teach placing a mark directly on the thumbnail; however, this concept is well known as shown by Iguchi (col. 22, lines 47 – 67; figure 15). Iguchi has the user trim an image by directly marking on it, the patent also teaches of placing

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written messages directly on the images as well as selecting faces by marking directly on the thumbnails.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Kato to allow a user to directly mark a thumbnail as taught by Iguchi. Allowing a user direct marking would make it easier for the user to see and understand the operation they are requesting and ensure they realize the operation would be performed on the overwritten thumbnail.

In regards to claim 18 Kato discloses, The method of claim 17, wherein said first designation mark is an alpha-numeric symbol (Figure 4; Figure 8; col. 5, lines 39 – 47).

In regards to claim 19 Kato discloses, The method of claim 17, wherein the step of performing said first action is based on a known location of said each thumbnail corresponding to said each image on which said first action is to be taken (col. 6, lines 26 – 33).

In regards to claim 20 Kato discloses, The method of claim 17, said thumbnail printout further including a print option symbol, further comprising the step of: placing an option designation mark directly on said print option symbol on said selection sheet to designate a print option, wherein the detecting step includes detecting said option designation mark (Figure 4: 103 is a print option symbol.); and wherein the step of performing said first action includes printing said each image on which said first action is to be taken using said print option based on a known location of said print option symbol (col. 6, lines 26 – 54).

In regards to claim 21 Kato discloses, The method of claim 20, wherein said print option symbol is one of a plurality of print option symbols, said option designation mark is one of a plurality of option designation marks, and said print option is one of a plurality of print options (Figure 4 shows several print options symbols, the designation mark can be a check mark or a number in figure 4.).

In regards to claim 22 Kato discloses, The method of claim 21, wherein each image of said plurality of images on which said first action is to be taken includes a first image on which said first action is to be taken and a second image on which said first action is to be taken, said step of said performing said first action including printing said first image using at least one print option of said plurality of print options and printing said second image using a different at least one print option of said plurality of print options (Figure 4).

In regards to claim 23 Kato discloses, The method of claim 17, wherein the step of performing said first action includes printing (col. 5, line 62 – col. 6, line 5).

In regards to claim 26 Kato discloses, The method of claim 17, wherein: the step of generating said selection sheet further includes placing a second designation mark directly on said thumbnail printout for each thumbnail of said plurality of thumbnails corresponding to each image of said plurality of images on which a second action is to be taken, said second designation mark being different from said first designation mark, and said second action being different from said first action (Figure 4, Figure 6, Figure 8); the step of detecting includes detecting both said first designation mark and said second designation mark by scanning said selection sheet with said scanner (col. 6,

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lines 26 – 33); and the step of performing includes performing both said first action and said second action based on said detecting both said first designation mark and said second designation mark respectively (col. 6, lines 34 – 53).

In regards to claim 28 Kato discloses, The method of claim 26, wherein said first designation mark has a first configuration, and said second designation mark has a second configuration different from said first configuration, wherein: said detecting both said first designation mark and said second designation mark includes detecting said first configuration and said second configuration respectively (col. 6, lines 26 – 33); and said performing both said first action and said second action is based on said detecting said first configuration and said second configuration respectively (col. 6, lines 26 – 53).

In regards to claim 48, claim 48 is rejected for the same reasons as claim 26. The argument analogous to that presented above for claim 26 is applicable to claim 48.

In regards to claim 50, claim 50 is rejected for the same reasons as claim 28. The argument analogous to that presented above for claim 28 is applicable to claim 50.

In regards to claim 51 Kato discloses, The method of claim 48, said thumbnail printout further including a print option symbol, further comprising the steps of: placing an option designation mark at said print option symbol on said selection sheet to designate a print option (col. 5, lines 25 – 47); and detecting said option designation mark by scanning said selection sheet with said scanner, wherein the step of performing said first action includes printing each said image on which said first action is to be taken using said print option (col. 6, lines 26 – 54).

In regards to claim 52 Kato discloses, The method of claim 51, wherein: said print option symbol is one of a plurality of print option symbols (Figure 4); said print option is one of a plurality of print options (Figure 4); and said option designation mark is one of a plurality of option designation marks, wherein each image of said plurality of images on which said first action is to be taken includes a first image on which said first action is to be taken and a second image on which said first action is to be taken (col. 5, lines 25 – 47); and the step of performing said first action includes printing said first image using at least one print option of said plurality of print options and printing said second image using a different at least one print option of said plurality of print options (col. 6, lines 26 – 54).

4. Claims 24, 25, 27, 29, 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato, Iguchi, and Lumley (7,009,726).

In regards to claim 25, the combination of Kato and Iguchi discloses many different types of actions that can be taken based on user selection on the selection sheet; however, the combination does not disclose deletion as one of those options. Lumley teaches (Figure 1, item 41; col. 2, lines 4 – 9) that a selection sheet for photos can be created that includes the option of deleting an image from the digital media.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to include a delete option, as taught by Lumley, in the selection sheet disclosed by the combination of Kato and Iguchi. Allowing the user to delete images directly from the selection sheet will save the user time, as the selection sheet is possibly the first time the user has seen the image, it is the first time he or she would

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realize they don't want to keep the image. As the idea behind both of these patents is to allow the user to work with digital media without the need of a computer including other operations the user could perform on a computer makes the combination more fully featured.

In regards to claim 24, claim 24 is rejected for the same reasons as claim 25, deleting an image would be the same as inhibiting printing.

In regards to claim 27, claim 27 is rejected for the same reasons as claim 25. The argument analogous to that presented above for claim 25 is applicable to claim 27.

In regards to claim 29, claim 29 is rejected for the same reasons as claim 25. The argument analogous to that presented above for claim 25 is applicable to claim 29.

In regards to claim 49, claim 49 is rejected for the same reasons as claim 25. The argument analogous to that presented above for claim 25 is applicable to claim 49.

5. Claims 30 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato, Iguchi, Yamada (6,089,766) and Miyake (4,905,090).

In regards to claim 30, the combination of Kato and Iguchi does not teach an alignment sensor that is used as a scanner. Yamada teaches (col. 9, line 57 – col. 10, line 61) that an alignment sensor can be used to scan in an image pattern. Yamada uses this alignment sensor only for the purpose of alignment, but the scanner clearly has the capability to scan in other items. However, it is a well-known concept to use a combination printhead/scanner head as shown by Miyake (col. 3, lines 3 – 12). The printhead/scanner disclosed by Miyake is not described as an alignment sensor. In combination Yamada and Miyake teach the concept of an alignment sensor that can be



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used as a scanner. Using an alignment sensor as a scanner would allow for added features without adding any new hardware to Yamada.

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use an alignment sensor, which acts as scanner (as taught by the combination of Yamada and Miyake) to the invention disclosed by Kato and Iguchi. Adding an alignment sensor to the combination would ensure more accurate printing, and using it as a scanner would allow for less hardware and a cheaper implementation.

In regards to claim 53, claim 53 is rejected for the same reasons as claim 30. The argument analogous to that presented above for claim 30 is applicable to claim 53.

6. Claims 31 – 40, 44, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato and Yoshihara (6,031,632), Yamada and Miyake.

In regards to claim 31, Kato as shown in the rejection of claim 30 discloses everything called for in this claim except for orientation marks. Using orientation marks with scanning is well known as shown by Yoshihara (Figure 7, items 1105 – 1108, col. 10, lines 28 – 33).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to use the orientation marks taught by Yoshihara on the selection sheet disclosed by Kato. Using orientation marks will ensure a more robust scan and lead to less error, and therefore fewer reprint operations.

In regards to claim 32 Kato discloses, The method of claim 31, wherein said at least one orientation symbol includes at least one elongate bar (Figure 7).

In regards to claim 33 Kato discloses, The method of claim 32, wherein said at least one elongate bar is printed in at least one corner of said thumbnail printout (Figure 7).

In regards to claim 34 Kato discloses, The method of claim 33, wherein said at least one orientation symbol is configured to indicate at least four possible orientations of said thumbnail printout (Figure 7).

In regards to claim 35 Kato discloses, The method of claim 34, wherein said at least one orientation symbol is at least four orientation symbols (Figure 7).

In regards to claim 36 Kato discloses, The method of claim 35, wherein a first orientation symbol is an elongate bar, a second orientation symbol is two elongate bars, a third orientation symbol is three elongate bars, and a fourth orientation symbol is four elongate bars (Yoshihara discloses 6 orientation marks in figure 7, it would have been obvious to one of ordinary skill in the art at the time of the invention to use any number of orientation marks. As long as the marks don't get so numerous they start to take away a significant portion of the selection page, more orientation marks will only increase accuracy, leading to fewer misreads and thus fewer times incorrect print jobs, or worse yet inappropriate deletions.).

In regards to claim 37 Kato discloses, The method of claim 36, wherein said orientation is determined based on detecting a number of elongate bars (Figure 7).

In regards to claim 38 Kato discloses, The method of claim 31, wherein the step of performing said first action is based on a known location of said at least one

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thumbnail based on the step of determining said orientation (This is the basic idea of using orientation marks.).

In regards to claim 39, claim 39 is rejected for the same reasons as claim 20. The argument analogous to that presented above for claim 20 is applicable to claim 39.

In regards to claim 40, claim 40 is rejected for the same reasons as claim 23. The argument analogous to that presented above for claim 23 is applicable to claim 40.

In regards to claim 44, claim 44 is rejected for the same reasons as claim 26. The argument analogous to that presented above for claim 26 is applicable to claim 44.

In regards to claim 46, claim 46 is rejected for the same reasons as claim 28. The argument analogous to that presented above for claim 28 is applicable to claim 46.

7. Claims 41, 42, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kato, Yoshihara, Yamada and Miyake as applied to claim 31 above, and further in view of Lumley.

In regards to claim 41, claim 41 is rejected for the same reasons as claim 24. The argument analogous to that presented above for claim 24 is applicable to claim 41.

In regards to claim 42, claim 42 is rejected for the same reasons as claim 25. The argument analogous to that presented above for claim 25 is applicable to claim 42.

In regards to claim 45, claim 45 is rejected for the same reasons as claim 42. The argument analogous to that presented above for claim 42 is applicable to claim 45.

In regards to claim 47, claim 47 is rejected for the same reasons as claim 42. The argument analogous to that presented above for claim 42 is applicable to claim 47.

***Response to Arguments***

8. Applicant's arguments filed 02/23/07 with respect to claims 17 – 29 and 48 – 52 have been fully considered but they are not persuasive.

9. Applicant's arguments with respect to claims 30 – 47 and 53 have been considered but are moot in view of the new ground(s) of rejection.

10. The applicant's primary argument with regards to claims 17 – 30 is focused on whether Iguchi teaches the concept of writing directly onto the index print or onto a transparency placed onto of the index print. The examiner pointed to col. 22, lines 47 – 67 and figure 15 to show that Iguchi teaches writing directly on the index print. In this cited paragraph Iguchi states "The trimming region designation information of the guide print P2 can be formed by the customer himself ***directly*** entering it on the frame image 10 using a ball-point pen, felt tipped pen, pencil or any desired writing tool W". The examiner would also like to point to col. 21, lines 48 – 64:

When consideration is given to the possibility that the trimming region designation information is directly formed on the frame image 10 using a writing tool in the same way as will be described later, the guide print P2 is preferred to be made of a material which permits rewriting with a writing tool on the surface where each frame image 10 is displayed. This is intended to ensure that once written instruction information can be easily erased and rewritten.

Unlike the normal lustrous print paper, the rewritable material has its surface matte-finished, and is treated to incorporate various surface conditions for ensuring a sufficient deposition of ink of a pencil lead and ball-point pen. Such a rewritable material should be used in the area of at least the frame image 10 and instruction information writer 11.

This language clearly suggests that the intent is to create a paper that can be written on directly by the user.

The applicant's representative points to the contents of primarily column 27 to argue that what Iguchi is really talking about when ever he states "directly" is really writing directly on the transparency. The examiner disagrees with this argument; the transparency concept is a different embodiment. From columns 21 through columns 26 Iguchi uses the term "directly", starting in column 27 Iguchi begins describing the transparency embodiment and begins using "not directly" instead. The examiner would also like to point to col. 27, lines 20 – 42:

A transparent material which is so transparent that the image is identifiable is laid on top of the surface of the print of other configuration. This will be explained in the case of the guide print P2 with reference to drawings. As shown in FIG. 20, it has approximately the same size as the guide print P2, and is positioned with respect to the image recorded on the guide print P2. Further, a transparent material P2a made of the material which allows rewriting with a writing tool W is laid on top of it. With this transparent material P2a laid on top of the guide print P2, it is assumed that region designation information for designating the trimming region, instruction information and other various types of information can be directly written on the transparent material P2.

Unlike the normal lustrous print paper, the rewritable material has its surface matte-finished, and is provided with surface conditions for ensuring a sufficient deposition of ink of a pencil lead and ball-point pen.

These two paragraphs parallel those pointed out at col. 21, lines 48 – 64, above. It is clear that Iguchi is describing two different embodiments. One using specially treated paper, which allows for the areas where thumbnails will be printed to be re-writeable, and a second embodiment, which places a transparent sheet over the index print.

***Allowable Subject Matter***

11. Claims 1 – 16 are allowed.

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12. The following is a statement of reasons for the indication of allowable subject matter: The art of record does not teach the concept of printing a confirmation and then performing an action in the area of thumbnail printout sheets. The examiner previously rejected this claim, but only because he over looked the phrase "on which said first action is to be taken". This language overcomes the concept of having the performance of the action be the confirmation for the action.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher L. Lavin whose telephone number is 571-272-7392. The examiner can normally be reached on M - F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher Lavin



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